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THOMAS E. HILL
EMRICH & DITHMAR, LLC
125 SOUTH WACKER DRIVE, SUITE 2080
CHICAGO IL 60606E

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OCT 30 2006

OFFICE OF PETITIONS

In re Application of:
Elliott :
Application No. 10/701,219 :
Filed: November 4, 2003 :
Attorney Docket No. 10/CIP(2) :
For: ADJUSTABLE PIPE REPAIR CLAMP
INSTALLATION TOOL

ON PETITION

This is a decision on the petition under 37 CFR 1.181, filed September 14, 2006 (certificate of mailing date September 12, 2006) to withdraw the holding of abandonment.

The petition under 37 CFR 1.181 is **DISMISSED**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to submit a proper reply to the January 31, 2006 final Office action which set an extendable three month period for reply. Applicant filed an amendment after final on May 2, 2006 (certificate of mailing date April 27, 2006). The amendment after final failed to place the application in condition for allowance. A Notice of Abandonment was mailed on September 1, 2006.

Petitioner requests that the holding of abandonment be withdrawn because the Office did not mail an Advisory action in response to the amendment after final filed on May 2, 2006 (certificate of mailing date April 27, 2006). Petitioner requests that applicant be advised as to whether the May 2, 2006 (certificate of mailing date April 27, 2006) amendment after final was entered in this application, and that the time to file an appeal or a RCE be extended to 30 days from issuance of a response to this request.

Petitioner is reminded that after a final action, there are only five possible replies: (1) a Notice of Appeal, (2) the filing of a continuing application, (3) a 37 CFR 1.129(a) submission, if appropriate, (4) an amendment after final that makes the case ready for issuance or (4) an RCE. To be a proper reply, an amendment after final must eliminate all of the Examiner's objections and rejections, and thus place the case in *prima facie* condition for allowance.

Petitioner's Amendment After Final failed to eliminate all of the Examiner's objections and rejections. The rules of practice are clear that prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last Office action, or refusal to admit the same, shall not operate to save the application from abandonment. "[T]he admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135." See 37 CFR 1.116(a).

Petitioner's failure to appreciate that the filing of a proposed amendment under 37 CFR 1.116 on May 2, 2006 (certificate of mailing date April 27, 2006) did not relieve petitioner of the burden of timely filing a notice of appeal or other proper response to avoid abandonment of the above-identified application is unfortunate, but it is not unavoidable delay. The abandonment of an application subject to a final Office action is not "unavoidable" within the meaning of 35 U.S.C. 133 and 37 CFR 1.137(a) in the situation in which the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. At 53162, 1203 Off. Gaz. Pat. Office at 89 (response to comment 66).

The fact that the Office did not mail an Advisory action does not change the fact that the application became abandoned because petitioner failed to submit a proper reply to the final Office action. The petition is dismissed.

Petitioner may wish to contact the examiner of record for information regarding whether or not the May 2, 2006 (certificate of mailing date April 27, 2006) will be entered for purposes of appeal.

Petitioner should consider filing a petition to revive under the unintentional delay standard of 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand:

U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By FAX: (571) 273-8300 - ATTN: Office of Petitions

Telephone inquiries may be directed to the undersigned at (571) 272-3230.



Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions